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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 09/719,231  | 02/22/2001  | Yoshihiko Matsukawa  | 2000-1663 A             | 7080             |
| 7590 01/13/2005<br>Wenderoth Lind & Ponack<br>Suite 800<br>2033 K Street NW<br>Washington, DC 20006 |             |                      | EXAMINER<br>DANG, DUY M |                  |
|   |             |                      | ART UNIT<br>2621        | PAPER NUMBER     |
| DATE MAILED: 01/13/2005   |             |                      |                         |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/719,231

Applicant(s)

MATSUKAWA ET AL.

Examiner

Duy M Dang

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 and 9-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Applicant's election with traverse of Species 4 filed 7/23/04 is acknowledged. The traversal is on the ground(s) that each claims 1, 8, 21 and 25 recites a common feature. This is not found persuasive because figure 4 does not disclose (1)an image selection means as recited in claim 21 and (2)output control means as recited in claim 25. Thus, claims 21 and 25 are not directed to Species 4 that corresponds to figure 4 and fourth embodiment described on the specification page 86 line 18 to page 91 line 21.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 4-7, and 9-49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement filed 7/23/04.

3. Applicant's amendment is advised in response to this office action to cancel all claims directed to non-elected species/inventions.

4. The copies of the initialized PTO-1449 (filed 12/11/00, 2/22/01, and 2/01/02) are accompanied herein.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-3 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following terms lack suitable antecedent basis: in claim 1, "the basis" recited in lines 2 and 7, "the plural" recited in line 8, "the positions and sizes" recited in lines 12-13, and "the

Art Unit: 2621

correlation” recited in line 17; and in claim 8, “the basis” recited in lines 2 and 5, “the correlation” recited in line 9.

Dependent claims 2-3 are also rejected for the same reasons as above.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claim 8 is rejected under 35 U.S.C. 102(e) as being anticipated by Nomizu [US Patent No. 6,301,391].

Regarding claim 8, Nomizu teaches:

predictive image generation means for generating image data of the predictive image similar to the target image, on the basis of image feature data indicating the feature of the target image [i.e., “similar image predictive coding portion” shown at 206 in figure 2];

entropy coding means for subjecting the image data of the target image to entropy coding utilizing the correlation in pixel values between the target image and the predictive image, and outputting entropy codes as coded image of the target image [i.e., code information producing portion” shown at 208 in figure 2]; and

said image coding apparatus outputting the entropy codes and the image feature data corresponding to the target image [see “code information” outputted from coding portion 103 of figure 2 and mentioned in col. 7 lines 60-65].

Art Unit: 2621

9. Claims 1-3 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duy M Dang whose telephone number is 703-305-1464. The examiner can normally be reached on Monday to Friday from 5:30AM to 2:00PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo H Boudreau can be reached on 703-305-4706. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

dmd  
12/23/04



Duy M. Dang  
Patent Examiner